

## REMARKS

Claims 1-54 and 56-78 are currently pending for the Examiner's review and consideration. No new matter has been added.

Claims 1-54 and 56-78 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,899,939 to Boyce *et al.* ("Boyce"), in view of U.S. Patent No. 6,206,923 to Boyd *et al.* ("Boyd"). Applicants respectfully traverse.

Applicants' independent claims 1, 21, 40, 41, 56, and 77 read as follows, with particular emphases to key terms, for the Examiner's convenience.

1. An implant comprising a body having a substantially tubular inner member and at least one substantially tubular outer member, each member being formed from a bone from a different region of the body and being formed with an exterior surface and an opening defining an interior surface, wherein the exterior surface of each inner member contacts the interior surface of no more than one other outer member.

21. An implant comprising a body formed from a core and a plurality of substantially tubular members, wherein each member has an outer tubular surface and an opening defining an inner tubular surface, the outer surface of the first member has about the same contour as the inner surface of the second member so that the first member may be received within the second member, the core being sized and configured to be received within the opening formed in the first member.

40. An implant comprising a plurality of substantially circular members, each member having a hole defining an opening, the implant further including a core sized and configured to fit within the innermost circular member, wherein the members are formed from at least two different bones selected from the group comprising a femur, tibia, humerus, fibula, ulna, and radius.

41. An implant comprising a substantially circular inner member and at least one substantially circular outer member, wherein the inner member is sized and configured to fit within an opening formed in the outer member, when coupled, the inner and outer members forming at least one securing region, the implant further including at least one insertable securing element adapted for placement in the at least one securing region, wherein the implant is formed from at least two different bones selected from the group comprising a femur, tibia, humerus, fibula, ulna, and radius.

56. An implant comprising a body having two outer annular members and at least one inner annular member, where at least one of the outer and inner annular members is formed from bone and the outer annular

members are coupled together to define a central opening for receiving the at least one inner member.

77. An implant comprising a body having at least two ring-shaped members formed from bone, wherein the innermost ring-shaped member has a longitudinal axis and an outer diameter, the outermost ring-shaped member has a longitudinal axis, an outer diameter, and a central opening defining an inner surface, the inner surface is sized and configured to receive the innermost ring-shaped member so that the longitudinal axis of the innermost ring-shaped member coincides with the longitudinal axis of the outermost ring-shaped member when the innermost ring-shaped member is received within the outermost ring-shaped member.

Boyce discloses taking a long bone and slicing it longitudinally to form bone layers, the layers being superimposed one on top of the other “in edge-to-edge fashion in a manner analogous to planking.” See Boyce at column 3, lines 58-67. Boyce teaches that the implant may be later machined into any desirable size and shape (*see id.* at column 4, lines 45-47).

Boyce does not disclose nor suggest members that are substantially tubular, substantially circular, annular, or ring-shaped, as recited in the respective independent claims emphasized above. Applicants respectfully submit that Fig. 1 represents diaphyseal bone from which the layers/sections are cut (column 2, lines 58-60) and that Fig. 2 represents a multi-layered wafer-like flat implant section (column 2, lines 61-64), neither of which disclose or suggest substantially tubular, substantially circular, annular, or ring-shaped members, as recited in the respective independent claims emphasized above. Further, Boyce discloses layers/sections that are sliced from bone and assembled “edge-to-edge,” which might represent upper/lower layers, but which do not disclose or suggest inner/innermost or outer/outermost members or members received within other members, as recited in the respective independent claims, as emphasized above. The Office Action also acknowledges, at the bottom of page 2, that Boyce does not disclose each member being formed from a different region in the body or from cancellous and cortical bone, as recited in independent claims 1, 40, and 41, as emphasized above. Thus, Applicants respectfully submit that Boyce does not come close to disclosing all the elements of the currently pending claims.

Furthermore, Boyd does not remedy the deficiencies of Boyce. The Examiner indicates that Boyd teaches a ring-shaped member at Fig. 9 and column 6, lines 10-20, but this is a single femoral ring, not a multi-member implant in which the members are substantially tubular,

substantially circular, annular, or ring-shaped, as recited in the respective independent claims emphasized above. Further, nowhere does Boyd disclose or even suggest that two separate members be used in its implants. Thus, neither Boyd, Boyce, nor even their combination, discloses or suggests all the elements of the currently pending claims. As a result, Applicants respectfully request that the aforementioned obviousness rejection based on the combination of Boyce and Boyd should be reconsidered and withdrawn.

Even assuming, *arguendo*, that the combination of Boyce and Boyd disclosed or suggested all the elements of the claimed invention, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to so combine the disclosures of Boyce and Boyd. Neither Boyd nor Boyce provides such a motivation, in that neither discloses or suggests that one of ordinary skill in the art should look to any other source, no less to Boyd or Boyce, for alterations to their teachings. Such a motivation is required in the references themselves for an obviousness rejection to stand. *See In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

In light of the foregoing remarks, Applicants respectfully submit that the instant claims of the present application are in condition for allowance, which action is respectfully requested. Should the Examiner disagree, it is requested that he contact either of Applicants' undersigned representatives regarding this Response or any aspect of this matter, if the Examiner believes that such a call would be helpful in expediting prosecution of the present application.

A Petition for Extension of Time for responding to the pending Office Action is enclosed herewith, along with provision for the required fee. No other fees are believed to be due for this submission. Should any additional fees be due, however, please charge such fees, and/or credit such overpayments, to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310.

Respectfully submitted,

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